REMARKS

In the application claims 14-22 remain pending. Claims 1-13 have been canceled without prejudice and may be pursued in a continuation application.

Pending claims 14-22 presently stand rejected. The reconsideration of the rejection of the claims is, however, respectfully requested.

Pending claims 14-22 presently stand rejected under 35 U.S.C. § 103 as being rendered obvious primarily by Suehira (U.S. Patent No. 6,922,697) as modified by Mason (U.S. Published Application No. 2001/0051918). In rejecting the claims it was acknowledged that Suehira fails to disclose, teach, or suggest, among other things, an IML file having IML tags that are used to create an invoice. Owing to this deficiency in Suehira, it was asserted that Mason discloses generating an HTML invoice "which implies that HTML tags are used to generate an invoice, where the HTML can be replaced by IML, a markup language for invoices." As such, it was concluded that Mason thus "provides the advantage to incorporate into Seuhira for effectively specifying a layout and selecting data for including in an invoice via sets of markup tags defined by a document type definition as desired."

In response to the rejection of the claims, it is first respectfully submitted that, to be "inherently" described in a reference, the reference "must make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill." More particularly, inherency "may not be established by probabilities or possibilities" and the mere fact that a certain thing may result from a given set of circumstances is not sufficient. See *Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991). Since nothing from within Mason can be said to make clear that HTML generated invoices "can be replaced by IML" as asserted in the rejection of the claims, i.e., Mason makes no mention of anything other than

HTML, it is respectfully submitted that Mason fails to "inherently" describe that which is missing from Seuhira and the rejection of the claims must be withdrawn.

Rather than make clear that HTML generated invoices "can be replaced by IML" as asserted in the rejection of the claims, upon reviewing Mason in its entirety it is evident that Mason, in fact, *teaches directly away* from the invention claimed and, for at least this reason, it is respectfully submitted that Mason cannot be said to suggest modifying Seuhira to arrive at the invention claimed as is required to maintain the rejection under 35 U.S.C. § 103.

Considering now Mason in detail, instead of teaching the desirability of using with an invoice generating application an IML file *having both* a first set of IML tags defined by a document type definition *that are used by the invoice generating application* to select data from a database of a customer service organization for inclusion in the invoice and a second set of IML tags defined by the document type definition *that are used by the invoice generating application* to specify a layout for the invoice including the selected data, as claimed, Mason teaches a system in which data is first extracted from work files based upon the location of the data within the work files as defined within a statement definition, which then compresses the data extracted from the work files into a Binary Large Object (BLOB) that is loaded into an Oracle database as a distinct statement record to be later accessed, and which thereafter generates an HTML invoice by extracting the pre-filtered data from the BLOB stored in the Oracle database whereupon the data extracted from the BLOB is placed into fields of an HTML invoice according to the definition described within nothing more than the template for the HTML invoice itself. (Paras. 0026, 0027, and 0028). Accordingly, since Mason teaches the desirability of using a statement definition to extract data from a customer service database for inclusion into nothing more than a BLOB and since Mason teaches the desirability of further using the template for the HTML invoice itself to define the layout of the HTML invoice into which the pre-filtered data within the BLOB is merely

placed, which is in direct contrast to that which is claimed, it is respectfully submitted that nothing from within Mason can be said to demonstrate that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have been motivated by Mason to modify Seuhira to include the claimed IML file and the claimed invoice generator which utilizes the IML file including both of its tags to generate invoice files in accordance with the IML file including both of its tags. For at least this reason it is respectfully submitted that the combination of Mason and Seuhira cannot be said to present a *prima facie* case of obviousness and the rejection of the claims must be withdrawn.

CONCLUSION

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fees are due, the Commissioner is authorized to charge any fee deficiency to deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted;

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